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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/828,384

04/19/2004

Jeffrey Clark Wicks

2095/US/2

4818

20686

7590

09/14/2006

DORSEY & WHITNEY, LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
370 SEVENTEENTH STREET  
SUITE 4700  
DENVER, CO 80202-5647

EXAMINER

GILBERT, ANDREW M

ART UNIT

PAPER NUMBER

3767

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/828,384	<b>Applicant(s)</b> WICKS ET AL.	
	<b>Examiner</b> Andrew M. Gilbert	<b>Art Unit</b> 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,8,9,13,14,19,20 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,10-12,15-18,21-24 and 26-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/3/2004</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 2, 3, 8, 9, 13, 14, 19, 20, 25 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6/28/2006.

2. Applicant's election without traverse of Terminal End Structure Species II; Syringe Needle Species I; Adapter Species II; Cartridge Species II in the reply filed on 6/28/2006 is acknowledged. Claims 1, 4-7, 10-12, 15-18, 21-24, and 26-29 are readable thereon. Additionally, claims 1, 4, 11, 12, 15, 22, and 23 are generic.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 7/3/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Objections***

4. Claim 23 is objected to because of the following informalities: Claim 23 recites the limitation "at least fluid guide" in ln 5. The Examiner believes the Applicant intended to recite "at least one fluid guide". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4-7, 10-12, 15-18, 21-24, 27 rejected under 35 U.S.C. 102(b) as being anticipated by Howson et al. Howson et al discloses an adapter for use in dispensing or withdrawing fluid from a container (10), or well, using a syringe (35), the adapter comprising: a main body (7) having a rim (19) formed at least partially around said main body and a collar (20) extending from said main body adjacent said rim; at least one aperture (29, 30), or fluid guide, formed through said main body from an upper portion of said main body to a lower portion of said main body; and wherein said main body is adapted to be positioned on an open top of the container such that said rim at least partially engages an edge of the open top while said collar is positioned adjacent the edge and at least partially inserted into the open top (Fig 3); wherein said aperture is linear (Fig 3; 28, 29, 30); wherein said aperture includes: a first portion (30) having a first cross sectional dimension; at least a second portion (29) having a second cross sectional dimension; and wherein said first cross sectional dimension is greater than said second cross sectional dimension (Fig 3); wherein said first cross sectional dimension is defined by a radius (Fig 3, 30); wherein said first cross sectional dimension is adapted to receive a luer (Fig 3-4; col 3, ln 64-col 4, ln 8) of the syringe; wherein said main body defines a recess (Fig 3); wherein a portion of said at least one aperture extends downwardly from said main body (31); further comprising a tubular protrusion extending from said main body (31); further comprising a plate extending from said main body (22).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Howson et al. Howson et al discloses the invention substantially as claimed except for expressly disclosing the tubular protrusion includes a terminal end structure having a criss-cross pattern formed therein. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have a terminal end structure having a criss-cross pattern formed therein because the Applicant has not disclosed that a terminal end structure having a criss-cross pattern formed therein provides an advantage, is used for a particular purpose, or solves a stated problem. Furthermore, one of ordinary skill in the art would have expected the Applicants invention to perform equally well with the terminal end of Howson et al because the terminal end of Howson et al performs substantially the same function in substantially the same manner. Therefore, it would have been an obvious matter of design choice to modify Howson et al to obtain the invention as specified in claim 26.

9. Claim 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howson et al in view of Fowles et al (5989237). Howson et al discloses the invention substantially as claimed except for an orientation structure connected with the said plate and the orientation structure including three tabs extending from the plate and adapted

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to engage an upper surface of the container. Fowles et al teaches that it is known to have an orientation structure connected with the said plate and the orientation structure including three tabs (84, 84a) extending from the plate and adapted to engage an upper surface of the container for the purpose of independently flexing to accommodate varying diameter vial closures. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the main body as taught by Howson et al with the orientations structure as taught by Fowles for the purpose of independently flexing to accommodate varying diameter vial closures.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew M. Gilbert whose telephone number is (571) 272-7216. The examiner can normally be reached on 8:30 am to 5:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Andrew Gilbert

KEVIN C. SIRMONS  
SUPERVISORY PATENT EXAMINER

